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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,924	07/21/2003	Charles D Linder	16925	5375
26637	7590	06/04/2004		

INTELLECTUAL PROPERTY LAW DEPARTMENT CASE LLC  
700 STATE STREET  
RACINE, WI 53404

EXAMINER	
PETRAVICK, MEREDITH C	
ART UNIT	PAPER NUMBER

3671

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

VB

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/623,924	LINDER, CHARLES D
	Examiner	Art Unit
	Meredith C Petravick	3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) 1-9 is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 21 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/21/2003</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

NOTE: Applicant claims are considered to be product by process claims since they recite that the transition section is spin formed. The invention defined in a product-by-process claim IS a product, NOT a process. In re Bridgeford, 357 F2d 679; 149 USPQ 55 (CCPA 1966). It is the patentability of the product claimed and NOT of the recited process steps which must be established. In re Brown, 459F2d 531; 173 USPQ 685 (CCPA 1972). In re Wertheim, 541 F2d 257; 191 USPQ 90 (CCPA 1976). A comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning the patentability of the product. In re Fessman, 489 F2d 742; 180 USPQ 324 (CCPA). In re Klug, 333 F2d 905; 142 USPQ 161 (CCPA 1964). Therefore, product-by-process claims are NOT construed as being limited to the product formed by the method claimed. In re Hirao et al., 76 F2d 650; 177 USPQ 523 (CCPA 1973).

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
2. Claims 5-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant's claim includes the limitation "funnel-like." It is unclear what application is trying to claim by this limitation since it is unknown what applicant considers like a funnel.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3 and 5-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Balmer 5,562,540.

Balmer discloses an agricultural combine having a rotor, a cylindrical rotor casing with a forward threshing region. The forward threshing region has a funnel-like transition section. The transition section is a metal sheet (33) with a smooth frusto-conical shape inner surface. The inner surface is seamless (Fig. 2). An annular lip extends outwardly from the transition section (Fig. 4).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Balmer.

Art Unit: 3671

Balmer discloses the claimed device except for the metal sheet having a thickness of at least about 4 millimeters. The dimension of the metal sheet is an obvious design choice. The specification states, "These dimensions are representative of a wide variety that can be employed. (Page 8, line 12-14)"

If applicant disagrees that the claims are product by process, then the following rejection will apply.

5. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Balmer in view of the Metalforming article and Metal Spinning article.

Balmer discloses the structure of the claimed transition section as detailed above. However, Balmer does not disclose the process by which the transition section is made.

The Metalforming article teaches that structural components of agricultural combines can be formed by spinners (Page 1, last column, line 30-42). The Metal Spinning teaches that spinning is a cost effective means of fabricating conical parts.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the transition section of Balmer by spinning as taught in the Metalforming and MetalSpinning articles as being cost effective.

### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3671

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meredith Petravick whose telephone number is 703-305-0047.

The examiner can normally be reached on Monday-Thursday from 7:00 a.m. - 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached at 703-308-3870.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is 703-308-1113. The fax number for this Group is 703-872-9306.



**Meredith Petravick  
Patent Examiner  
Group Art Unit 3671**

May 25, 2004